

REMARKS

Claims 1, 2 and 4-7 remain in the application. The applicant has cancelled claim 3.

NOVELTY REJECTIONS

The Office Action rejects claims 1, 2, 5, and 7 as being anticipated by Parthesarathy *et al* (US6353926B1) under 35 U.S.C. § 102(e), which states, in pertinent part, that an applicant is not entitled to a patent on an invention if that invention was disclosed in a US patent that issued from an application that another person filed before the applicant's invention date. According to the Office Action, Parthesarathy *et al*, a US patent that issued on an application filed 29 February 2000, disclose a method including steps satisfying all of the limitations of claims 1, 2, 5, and 7.

Claim 1 recites a method of updating a software application installed on a user's computer using a software update channel. When an application is installed on the user's computer, a subscription is made to a corresponding software update channel. At periodic intervals, the installed software makes use of this update channel to interrogate a remote database to determine if an update for the installed application is available, and if it is, the update files are automatically downloaded via software update channels. Once the update files have been downloaded to the user's computer, the user is notified that the updates are available for installation. The notification may be by a pop-up dialogue box or by an e-mail message. The software update channel is effectively a portion of the bandwidth of the user's conventional Internet, or network, connection that is reserved for the separate communication processes between a user's PC and the remote database. The connection is therefore a direct data connection and, as such, is prone to experiencing access problems through security measures such as firewalls, as explained in the present application.

As defined in the amended claim 1, the invention comprises a method of updating computer software and/or data in a recipient computer. According to the method of claim 1, the recipient computer sends an update request as an e-mail message to an owner computer. The owner computer analyzes the update request and prepares a corresponding update response. The owner computer sends the update response as an e-mail message to the recipient computer. The recipient computer responds to the update response by updating the software and/or data. What, among other things, characterizes or distinguishes the method of amended claim 1 from the prior art is that the owner computer's analysis of the update request and its preparation and sending of a corresponding update response are all *automatic* and are performed in response to receipt of the update request e-mail. Also, unlike prior art methods, the updating of software and/or data in the recipient computer is an *automatic* response to receipt of the update response from the owner computer, and one or more files to be updated are sent as *attachment files* in the e-mail message.

In other words, the Applicant's amendments to claim 1 clarify that the preparation of the update response occurs automatically in response to receiving the update request e-mail and that the update response e-mail includes one or more files that are to be updated as e-mail attachment files. This latter feature was originally recited in claim 3, which has now been cancelled. In addition to clarifying that the updating method of claim 1 occurs entirely automatically, the amendments also recite that this is done using conventional e-mail messages only. The exclusive use of e-mails in the updating method is significant. As explained in the specification of the present application, the use of e-mails avoids any problems in transferring the data, such as providing access to the recipient computer through company firewalls, or other security arrangements.

Claim 1 of the present application, as amended, explicitly recites that the recipient computer, analogous to the individual user's computer discussed by

Parthesarathy *et al*, sends an update request as an e-mail message to an owner computer, analogous to the remote database disclosed in Parthesarathy *et al*. Additionally, claim 1 explicitly recites that the owner computer sends the prepared update response as an e-mail message, with one or more files to be updated sent as attachment files in that e-mail message. Finally, as amended, claim 1 now recites that the recipient computer automatically responds to the update response by updating the software and/or data. Parthesarathy *et al*. only disclose the use of a software channel, i.e. direct data link, to achieve communication between the recipient computer and owner computer and makes no disclosure of the use of e-mails or e-mail attachments to achieve this particular communication. It is therefore submitted that Parthesarathy *et al*. do not anticipate claim 1 as now amended. Neither is there any teaching or suggestion that would motivate one skilled in the art to modify the method of Parthesarathy *et al*. to include all these features.

#### OBVIOUSNESS REJECTIONS:

The Office Action rejects claim 3 under 35 U.S.C. § 103(a) as being unpatentable over Parthesarathy *et al* in view of Davis *et al* (US5937160). According to the Office Action, Parthesarathy *et al* disclose all the limitations of claims 1, 2, and 3 except for the step, recited in claim 3, in which the files updated in the update response are sent as attachment files in the e-mail message. The Action indicates that Davis *et al* disclose such a step at 9:1-10 and that it would have been obvious to modify the Parthesarathy *et al* method to include the Davis *et al* step of sending updated files as e-mail attachments, "because, using attachments during emailing is a general practice and enables documents of different formats to be transmitted".

The Applicant maintains that this line of reasoning doesn't properly support the obviousness determination regarding claim 3. It's well settled that, to support an obviousness determination, one must show why a skilled person, confronted with the same problem as the inventor and with no knowledge of the claimed invention, would

select the elements from the cited prior art references for combination in the manner claimed. To help reduce the likelihood of hindsight-type analyses in these situations, the courts have held that an examiner, to support an obviousness finding, must show a motivation to combine the references that create the case of nonobviousness. See, e.g., *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457-1458 (Fed. Cir. 1998). This motivation to combine may be found either in prior art teachings, the knowledge of persons of ordinary skill in the art, or in the nature of the problem solved. *Id.* at 1458. In *In re Rouffet*, the Board's finding of obviousness was reversed because the Board, instead of showing a motivation to combine from one of these sources, argued that motivation could be found in the high level of skill in the art. Similarly, the present Office Action argues that motivation can be shown by identifying an *advantage* that's realized by sending updated files as e-mail attachments, i.e., because it "enables documents of different formats to be transmitted." However, while the level of skill in the art is at least part of the judicially defined inquiry for a suggestion to combine, the ability to identify or think up an advantage is not. If the ability to identify or think up an advantage were alone sufficient to supply a motivation to combine, then, because there is at least some advantage to almost all claimed combinations, the test would be useless to preclude hindsight analyses.

Although motivation need not be found by identifying an *explicit* teaching or suggestion in all cases, it's not enough to simply identify an advantage. There must at least be some *implicit* teaching or suggestion in the prior art or general knowledge that would have motivated one skilled in the art to combine the references. *In re Oetiker*, 24 USPQ2d 1443, 1446-1447 (Fed. Cir. 1992); *In re Rouffet* at 1458 (motivation may be found in "the nature of the problem to be solved . . ."). To show that there's an implicit suggestion, the Examiner must show that one skilled in the art would know to use a prior art teaching to solve the problem *that the Applicant sought to solve* through the invention in question. *In re Oetiker* at 1446-1447. To do this, the Examiner must identify the problem that the Applicant intended his invention to solve, the problem that the prior art teaching solves, and then show that the two problems are the same or at least similar to one another. Here, again, it's not sufficient to merely identify an advantage that the

combination would realize. In any event, the Applicant maintains that there is neither an explicit nor an implicit teaching that would provide the requisite motivation to combine the references to arrive at the invention of claim 3.

In addition, upon closer examination of Davis *et al* it becomes apparent that there are significant differences between the method disclosed in this document and the method recited in claim 1 of the present application. For example, while the Davis *et al* patent does teach a method of updating HTML documents, i.e. web pages, via e-mail, it also teaches that e-mails must be manually generated because the text of the e-mail is essentially a series of editing instructions referring to the web page to be updated. Although an "attachment field" may be included in the update e-mail, the only use for this attachment field is for attaching any binary file including graphical or image files, audio files or video files that are required for the web page (See column 9, lines 33 to 35). At no point do Davis *et al* disclose the possibility of automatically generating the update e-mails, nor of generating the e-mails in response to receiving an update request e-mail from the computer to be updated. However, the most important distinction is that in the method of Davis *et al*, it's the text of the e-mail message that specifies how a file is to be updated, in contrast to the update files being attached themselves to the e-mail, as recited in claim 1 of the current application. Given that Parthesarathy *et al* disclose only the use of a direct data link between recipient and owner computer, the Applicant maintains that there is no motivation for a person skilled in the art to try to apply the teachings of Davis *et al*, which relies on the transmission of a manually generated e-mail, to Parthesarathy *et al*. Furthermore, even if one were to attempt to combine the teachings of these references, a method of updating computer software and/or data according to claim 1 of the current application would not result. This is because neither Parthesarathy *et al* nor Davis *et al* teach the transmission of the actual update files as e-mail attachments.

The Office Action rejects claims 4 and 6 under 35 U.S.C. § 103(a) as being unpatentable over Parthesarathy *et al*. in view of Cantos *et al*. (US6529784B1).

Regarding claim 4, according to the Office Action, Parthesarathy *et al* disclose all the limitations of claims 1 and 4 except for the step recited in claim 4 in which the update response is protected by a password. According to the Action Cantos *et al* do disclose such a step at 10:60 and it would therefore have been obvious to modify the Parthesarathy *et al.* method to include the Cantos *et al.* password protection step "because it ensures that communications between the control server and agents associated with the customer network are secure and uncorrupted" (Cantos 10:56-60).

Here, again, however, the Office Action appears to have identified an advantage rather than identifying either an explicit or implicit teaching or suggestion that would motivate one skilled in the art to combine the references. The Applicant maintains that there is neither an explicit nor an implicit teaching that would provide the requisite motivation to combine the references to arrive at the invention of claim 4.

Regarding claim 6, the Office Action merely includes a copy of the text of claim 6 and a citation to column 4, lines 56-60 of Cantos *et al.* As such, the Applicant asks that the Examiner clarify and explain this rejection and provide the Applicant an additional opportunity to respond.

In any event, the Applicant maintains that both Cantos *et al.* and Ziese disclose updating mechanisms that transfer data over networks using direct communication techniques and in a manner similar to that discussed in Parthesarathy *et al.* Neither document discloses the use of e-mails or e-mail attachments to accomplish this communication. Consequently, there is no additional relevant teaching in either these two documents over and above that already discussed above with the relation to Parthesarathy *et al* and Davis *et al.*

The Applicant maintains that the advantages provided by the method of updating computer software and/or data according to claim 1 as now amended is that the process is entirely automatic, requiring no user interaction at any stage, and that the

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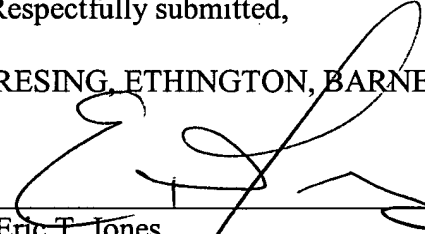
updates are applied automatically without any interruption of the facilities provided by the recipient computer. Furthermore, this automatic process is achieved in a manner that is entirely transparent to the general security features often applied to communications networks, such as firewalls and virus scanning systems.

Claims 1, 2, and 4-7 recite patentable subject matter and are allowable. Therefore, the applicant respectfully submits that the application is now in condition for allowance and respectfully solicits such allowance. Please favorably reconsider the outstanding office action.

I authorize the Assistant Commissioner to charge any deficiencies, or credit any overpayment associated with this communication to Deposit Account No. 50-0852. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

RESING, ETHINGTON, BARNES, KISSELLE, P.C.



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